

IN THE UNITED STATES PATENT AND TRADEMARK OFFICEIn re application of: **Roger Q. SMITH**Serial No.: **09/153,621**Filed: **September 15, 1998**For: **HEAVY-DUTY AUDIO EQUIPMENT**Assistant Commissioner for Patents
Washington, DC 20231Examiner: **T. Dinh**Group Art Unit: **2841**# 8/a
8/3/00
InlerAMENDMENT

I, Adan Ayala, Reg. No. 38,373, certify that this correspondence is being deposited with the U.S. Postal Service as first class mail in an envelope addressed to the Commissioner of Patents and Trademarks, Washington DC 20231 on July 24, 2000

[Signature]
Adan Ayala

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Dear Sir:

In response to the Office Action mailed June 21, 2000, please amend the above-identified application as follows:

IN THE SPECIFICATION:

Lines 9-10 of the Abstract: Delete "Also disclosed herein is a method for manufacturing an audio equipment."

IN THE CLAIMS:

Claim 20, line 1: Delete "18" and substitute therefor -19--.

REMARKS

Applicant would like to extend his sincere thanks to the Examiner for conducting telephone interviews on June 28, 29 and 30, 2000, to clarify the Examiner's rejection. The following remarks address the issues raised in the Office Action and during the interviews.

Currently in the application are Claims 1-20.

In the Office Action, the Examiner required an election between two groups of claims: Group I (Claims 1-6 and 15-20) and Group II (Claims 7-14). During a telephone conversation, Applicant's attorney provisionally elected Group I. Applicant hereby affirms such election.

The Examiner also noted that the information disclosure statement filed on December 9, 1998 fails to comply with 37 CFR § 1.98(a)(1) because it failed to include a list of all patents submitted to the Office. Applicant hereby attaches form PTO-1449, which was inadvertently excluded from the information disclosure statement.

The Examiner objected to the drawings under 37 CFR § 1.83(a) for allegedly failing to show every feature of the invention. In particular, the Examiner noted that the element "audio circuitry" is not shown in the drawings and thus must be shown or canceled from the claim. In response, Applicant notes that the "audio circuitry" can be different elements, including, for example, radio circuitry 44, radio tuner 45 and/or amplifier 46, etc. Therefore, all claimed elements are shown in the figures.

The Examiner also objected to the abstract because of the withdrawal of the non-elected claims. Accordingly, the Examiner is requesting an amendment to the abstract. In response, Applicant believes amending the abstract is not necessary. Under 37 CFR § 1.72 and MPEP § 608.1(b), the purpose of an abstract is to provide a statement of the subject

matter covered by the technical disclosure. In other words, the abstract relates to the specification, not the claims. Because the specification also discloses a method of manufacturing, the abstract should include that information. Nevertheless, for the sake of expediency, Applicant has deleted lines 9-10 of the abstract, as suggested by the Examiner.

The Examiner rejected Claims 1-6 and 15-20 under 35 USC § 103(a) as being unpatentable over US Patent No. 5,771,305 ("Davis"). This rejection is respectfully traversed. For the sake of clarity, Applicant will address the Examiner's rejection as to Claims 1-6 and 15-20 separately.

Claim 1 calls for an audio equipment comprising a housing, audio circuitry installed within the housing, and a first protective bar flexibly connected to the housing. Claim 2 is dependent upon Claim 1 and further calls for a handle attached to the first protective bar.

Admittedly, Davis discloses a housing 12 containing an audio circuitry, and that the housing is flexibly connected to motorcycle handlebars. However, these motorcycle handlebars are not protective bars as called for in Claim 1.

To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. MPEP § 2143.03 (citing *In re Royka*, 180 USPQ 580 (CCPA 1974)). "*All words in a claim must be considered in judging the patentability of that claim against the prior art.*" *Id.* (quoting *In re Wilson*, 165 USPQ 494, 496 (CCPA 1970)) (emphasis added). In the present case, the Examiner has failed to show that the handlebars are "protective."

As discussed in the specification, the protective bar is provided to protect the housing from being destroyed at a jobsite because of: (1) tools being dropped on the

housing; or (2) the radio falling down. In Davis, however, the handlebars do not serve to protect the radio. They only serve to support the radio in place. Accordingly, they are not a “protective” bar as called for in Claim 1. Therefore, Davis cannot render Claim 1 and its dependent claims unpatentable.

Furthermore, the Examiner has not issued a proper rejection against Claim 2. Assuming for the sake of argument that the Davis handlebars constitute a protective bar, the Examiner has failed to show “a handle attached to the first protective bar,” as called for in Claim 2.

In his Office Action, the Examiner notes that a handle 14 attached to the bars. Such argument fails for two reasons. First, element 14 is not a handle. Instead, element 14 is a top flap of the main compartment. Davis, col. 3, line 12. Assuming for the sake of argument that top flap 14 is a handle, such flap is not connected to the handlebars. As shown in FIG. 4 of Davis, no contact exists between flap 14 and the handlebars. Accordingly, Davis fails to show all the claimed limitations, and thus cannot render Claim 2 unpatentable.

Referring now to Claims 15-20, independent Claim 15 calls for an electronic equipment comprising a main housing, and a receptacle assembly for receiving a battery flexibly connected to the main housing. Claim 16 is dependent upon Claim 15, and further requires that the receptacle assembly comprises a receptacle housing and a flexible gasket disposed between the receptacle housing and the main housing. Claim 17 is dependent upon Claim 16, and further requires that the receptacle assembly comprises at least one retainer disposed on the housing to prevent disengagement of the gasket. Claim 18 is dependent upon Claim 16, and further requires that the gasket is made of

rubber or elastometer. Claim 19 is dependent upon Claim 15, and further requires a door hingably connected to the main housing and opposite of the receptacle assembly. Finally, Claim 20 is dependent upon Claim 19, and further requires that the door have a spring disposed thereon to bias a battery disposed in the receptacle assembly towards a connecting position.

In the Office Action, the Examiner rejected Claim 15 based on Davis. In his analysis, the Examiner did not comment where the Davis device has the receptacle. During the phone interviews, the Examiner finally admitted that Davis does not show a receptacle assembly, but that it is well known in the art to have a receptacle assembly. As to the requirement that the receptacle assembly be flexibly connected to the main housing, the Examiner relied on Fredman v. Harris-Hub Co., 163 USPQ 397 (N.D. Ill. 1969).

Such rejection is improper for two reasons. First, the Examiner's reliance on allegedly well known prior art is improper under MPEP § 2144.03. Second, the Examiner's reliance on Fredman is improper under MPEP § 2144.04.

The Examiner's reliance on allegedly well known prior art is improper under MPEP § 2144.03 for several procedural reasons. Admittedly the Examiner may take "official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being 'well-known' in the art." MPEP § 2144.03, at 2100-114, *citing In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420 (CCPA 1970). "This rule is not, however, as broad as it first might appear," and must be construed narrowly "with an eye towards narrowing the scope of any conclusions to be drawn therefrom." *Ahlert*, 165 USPQ at 420.

Accordingly, the judicially noticed facts must only “serve to ‘fill the gaps’ which might exist in the evidentiary showing.” MPEP § 2144.03, at 2100-115, *citing Ahlert*, 165 USPQ 418 at 421. For example, an Examiner can take judicial notice that “it is old to adjust the intensity of a flame in accordance with heat requirements” in a welding process. *See Ahlert*, 165 USPQ at 420-21.

Judicially noticed facts “should not comprise the principle [sic] evidence upon which a rejection is based.” MPEP § 2144.03, at 2100-115, *citing Ahlert*, 165 USPQ at 421 (*Ahlert* originally read “principal”). In the present application, the alleged well-known art is the principal evidence upon which the rejections are based as, if the Examiner removes such art from consideration, no proper rejection can exist against Claim 15, as the Examiner has admitted that Davis does not show a receptacle assembly. Therefore, the Examiner cannot base his rejections on the alleged well-known art. Accordingly the rejections based on Davis should be withdrawn.

These procedural issues are not just mere technicalities. Applicants cannot attack the rejections on the substantive merits because of the Examiner’s improper reliance on uncited art. Accordingly, Applicants’ “rights to fair notice and an opportunity to be heard” have been compromised. *See Ahlert*, 165 USPQ at 421. Therefore, Applicants hereby request that the Examiner cite a reference to prove that “it is well settled ... to provide a ... manual means to replace automatic activity,” or explain why no evidence is required, in the next Office Action. *See* MPEP § 2144.03, at 2100-115. Otherwise, the Examiner should withdraw the rejections and allow the pending claims.

The Examiner’s reliance on Fredman is inappropriate under MPEP § 2144.04. Under the MPEP, the Examiner may use the rationale used by the court “if the facts in a

prior legal decision are sufficiently similar to those in an application under examination.”

However, the facts of the present case and Fredman are not similar. In Fredman, the Court was examining whether Claim 4 of the patent-in-suit was infringed, rather than whether the claim was obvious. 163 USPQ at 401. The Court noted that words such as “flexibility” are relative, since virtually anything will flex if enough pressure is applied to it. *Id.* The Court did not find however that the claim was obvious and thus invalid, even though it invalidated at least Claims 1-3 of the patent-in-suit. *Id.* at 400-01. Why? Because the claim was unobvious over the prior art based partly on the flexible requirement.

Rather than find the claim invalid, the Court found lack of infringement because the accused unit did not flex or deflect as called for in the claim. *Id.* at 401. In other words, the Court found that the “flexible” element was an actual element of the claim, and found lack of infringement because of lack of such element in the accused product. Therefore, the Court’s statement should not be interpreted broadly, as suggested by the Examiner.

In conclusion, the facts of Fredman are not similar to the present case. Accordingly, the Examiner’s reliance on this case is improper under MPEP § 2144.04. Therefore, the Examiner should withdraw such rejection or allow the claims.

Even assuming for the sake of argument that Claim 15 is properly rejected based on Davis, the Examiner has failed to provide prima facie obviousness rejections on Claims 16-20.

As to Claim 16, the Examiner has failed to show where the Davis radio has a receptacle housing and a flexible gasket between the receptacle housing and the main

housing. Assuming that Davis has a receptacle and a receptacle housing inside housing 12, the Examiner has failed to show a flexible gasket between the receptacle housing and housing 12. The Examiner instead has pointed at gasket 60, which is disposed outside housing 12. How can a gasket to be disposed between a first element and a second element inside the first element be outside of the first element? During the telephone interviews, the Examiner provided no explanation. Applicant suggests that such explanation is not logically possible. Therefore, the Examiner should allow Claim 16 and its dependent claims.

As to Claim 19, the Examiner has failed to show where the Davis radio has a door hingably connected to the main housing and opposite of the receptacle assembly. Similarly, the Examiner has failed to show where the Davis radio has a spring disposed on the door to bias a battery towards a connecting position. Instead, the Examiner notes that it is “well known in the art” to provide such elements.

The Examiner’s reliance on allegedly well known prior art is improper under MPEP § 2144.03 for several procedural reasons. Admittedly the Examiner may take “official notice of facts outside of the record which are capable of instant and unquestionable demonstration as being ‘well-known’ in the art.” MPEP § 2144.03, at 2100-114, *citing In re Ahlert*, 424 F.2d 1088, 165 USPQ 418, 420 (CCPA 1970). “This rule is not, however, as broad as it first might appear,” and must be construed narrowly “with an eye towards narrowing the scope of any conclusions to be drawn therefrom.” *Ahlert*, 165 USPQ at 420.

Accordingly, the judicially noticed facts must only “serve to ‘fill the gaps’ which might exist in the evidentiary showing.” MPEP § 2144.03, at 2100-115, *citing Ahlert*, 165 USPQ 418 at 421. For example, an Examiner can take judicial notice that “it is old to

adjust the intensity of a flame in accordance with heat requirements” in a welding process.

See Ahlert, 165 USPQ at 420-21.

Judicially noticed facts “should not comprise the principle [sic] evidence upon which a rejection is based.” MPEP § 2144.03, at 2100-115, *citing Ahlert*, 165 USPQ at 421 (*Ahlert* originally read “principal”). In the present application, the alleged well-known art is the principal evidence upon which the rejections are based as, if the Examiner removes such art from consideration, no proper rejection can exist against Claims 19-20, as the Examiner has admitted that Davis does not show a door or a spring. Therefore, the Examiner cannot base his rejections on the alleged well-known art. Accordingly the rejections based on Davis should be withdrawn.

These procedural issues are not just mere technicalities. Applicants cannot attack the rejections on the substantive merits because of the Examiner’s improper reliance on uncited art. Accordingly, Applicants’ “rights to fair notice and an opportunity to be heard” have been compromised. *See Ahlert*, 165 USPQ at 421. Therefore, Applicants hereby request that the Examiner cite a reference to prove that “it is well settled ... to provide a ... manual means to replace automatic activity,” or explain why no evidence is required, in the next Office Action. *See* MPEP § 2144.03, at 2100-115. Otherwise, the Examiner should withdraw the rejections and allow the pending claims.

In view of the foregoing, all the claims are patentable and the application is believed to be in condition for formal allowance. Reconsideration of the application and allowance of Claims 13 and 15-29 are respectfully requested.

No fee is due for the present amendment. Nevertheless, the Commissioner is authorized to charge payment of any fees due in processing this response, or credit any overpayment to Deposit Account No. 02-2548.



Respectfully submitted,

A handwritten signature in black ink, appearing to read "Adan Ayala".

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